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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 09/494,253 | 01/31/2000 | Osamu Yamada | 44239-066 | 3198 |
| 20277 | 7590 | 08/11/2005 | EXAMINER | |
| MCDERMOTT WILL & EMERY LLP 600 13TH STREET, N.W. WASHINGTON, DC 20005-3096 | | | TRAN, DOUGLAS Q | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2624 | |

DATE MAILED: 08/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/494,253

Applicant(s)

YAMADA ET AL.

Examiner

Douglas Q. Tran

Art Unit

2624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on RCE on 16 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-15 and 17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9-14 and 17 is/are rejected.
- 7) ☒ Claim(s) 15 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 6/9/05; 5/16/05.

DOUGLAS Q. TRAN
PRIMARY EXAMINER

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 9, 11, 12, and 17 are rejected under 35 U.S.C. 102(e) as being anticipated by Oki (JP Patent No. 10-262141).

As to claim 9, Oki teaches an image formation apparatus (fig. 1) comprising:

an input unit entering image data (communication control unit 6 in fig. 1 for entering image data from communication line 6a in fig. 1),

a printer unit printing image data (printer unit 5 in fig. 1 for printing image data),

a memory (i.e., the report/printing report designation storage means 10 in fig. 1) storing trigger information to initiate execution of control operation and said control operation in correspondence (lines 19-25 on page 6 describes that the storage means 10 for storing the trigger information including control operation such as the printing report designation and reception report designation is initiated by classified image data storage means 11),

a detector (i.e., CPU 7) detecting additional information including said trigger information from said image data (page 6, line 19-22 describes that the additional information including the trigger information such as the printing report designation and reception report designation is detected from image data such as the reception data) , and

a controller (i.e., CPU 7) responsive to detection of said trigger information to execute said control operation corresponding to said trigger information stored in said memory,

wherein said control operation includes a transmission operation transmitting print information related to printing of said image data to a destination (lines 19-23 on page 6 describes the CPU 7 detects the predetermined control operation from the trigger information such as the printing report designation and then, lines 16-22 on page 7, control proceeds to step S35 where the printing report destination is read out from memory 8, which includes the printing report designation memory 17 in fig. 1, and the generated printing report is transmitted to a destination such as the transmitting side).

As to claim 11, Oki teaches the image formation apparatus according to claim 9, wherein said print information includes information indicating an event of printing said image data (page 7, lines 21-22 and page 8, lines 8-13: the print report would be considered as a report for event of printing of image data).

As to claim 12, Oki teaches the image formation apparatus according to claim 9, wherein said print information includes a print condition in printing said image data (page 7, lines 21-22 and page 8, lines 8-13: the print report would be considered as a report for event of print condition in printing of image data).

As to claim 17, An image recording apparatus comprising:

an input unit entering image data (communication control unit 6 in fig. 1 for entering image data from communication line 6a in fig. 1),

a record unit recording input image data on a recording medium (printer unit 5 in fig. 1 for printing image data on a sheet),

a detector (CPU 7 in fig. 1) detecting additional information from said image data, said additional information including trigger information to initiate execution of predetermined control operation data (page 6, line 19-25 describes that the additional information including the trigger information such as the printing report designation and reception report designation is detected from image data such as the reception data in which the trigger information including control operation such as the printing report designation and reception report designation is initiated by classified image data storage means 11), and

a controller (i.e., CPU 7) executing said predetermined control operation in response to detection of said trigger information, wherein said predetermined control operation includes a transmission operation transmitting information related to recording of said image data to a destination (lines 19-23 on page 6 describes the CPU 7 detects the predetermined control operation from the trigger information such as the printing report designation and then, lines 16-22 on page 7, transmitting the printing report to a destination such as the transmitting side based on the printing report destination from memory 8).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 10, 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oki in view of claim 9 in combination with Ikenoue et al. (US Patent No. 5,671,277).

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As to claim 10, Oki discloses every feature discussed in claim 9, however Oki does not teaches of an operation unit setting the trigger information and control operation in corresponding.

Ikenoue teaches of an operation unit (i.e., 4 in fig. 13) setting the trigger information and control operation in corresponding (col. 9, line 67 to col. 10, lines 4, 8-11).

It would have been obvious to modify the operation unit 2 in fig. 1 of Oki for setting trigger information and control operation in corresponding as taught by Ikenoue. The suggestion for modifying the operation unit of Oki can be reasoned by one of ordinary skill in the art as set forth above by Ikenoue because the modified printing system would increase the functionalities of the operation unit for setting the trigger information and control operation in corresponding.

As to claim 13, Oki discloses every feature discussed in claim 9. However Oki does not teaches the control operation includes a print operation print out the image data according to a predetermined print condition.

Ikenoue teaches the control operation includes a print operation print out the image data according to a predetermined print condition (col. 10, lines 4-7).

It would have been obvious to modify the control operation of Oki for including a print operation print out the image data according to a predetermined print condition as taught by Ikenoue. The suggestion for modifying the control operation of Oki can be reasoned by one of ordinary skill in the art as set forth above by Ikenoue because the modified printing system would increase the functionalities of the control operation for a print operation print out the image data according to a predetermined print condition.

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As to claim 14, Oki discloses every feature discussed in claim 9. However, Oki does not teach the control operation includes an image processing operation processing the image data according to a predetermined image processing condition.

Ikenoue teaches the control operation includes an image processing operation processing the image data according to a predetermined image processing condition (col. 10, lines 4-7).

It would have been obvious to modify the control operation of Oki for including an image processing operation processing the image data according to a predetermined image processing condition as taught by Ikenoue. The suggestion for modifying the control operation of Oki can be reasoned by one of ordinary skill in the art as set forth above by Ikenoue because the modified printing system would increase the functionalities of the control operation including an image processing operation processing the image data according to a predetermined image processing condition.

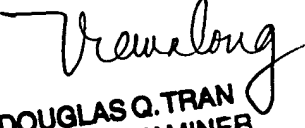
Allowable Subject Matter

5. Claim 15 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Douglas Q. Tran whose telephone number is (571) 272-7442 or E-mail address is douglas.tran@uspto.gov.

Aug. 01, 2005


DOUGLAS Q. TRAN
PRIMARY EXAMINER